

REMARKS

Claims 1-25 were previously pending in the application. By this Response, claims 1-9, 11, 12, 14, 15, 17, 18, 20-23 and 25 have been amended to provide clarification, better track current practical implementations, and/or correct minor typographical informalities. Applicants submit that support for the amendments may be found throughout the originally filed specification, drawings, and claims, and that no new matter has been added by way of this Response. Applicants further submit that the original claims are in condition for allowance and explicitly reserve the right to add/pursue the claims as originally filed at a later date and/or in one or more continuation/divisional application. Applicants respectfully request reconsideration of the instant application in view of the foregoing amendments and the following remarks.

Claim Objections

Claims 5, 13, 20, 22 and 25 have been objected to as allegedly containing particular typographical informalities. Though the pending rejection refers to claim 13 (and also to claim 12) in the objection, Applicants believe that neither claims 13 nor 12 contain the informalities alleged to exist by the pending rejection. Applicants do note that original claim 14 referred to "normalized" instead of "normalized." Accordingly, Applicants have amended claims 5, 14, 20, 22 and 25 to correct minor typographical informalities and submit that the Examiner's objections to the claims have been overcome. Should the Examiner maintain objections with respect to either claims 12 or 13, Applicants respectfully request further clarification as to the nature of those objections.

Claim Rejections - 35 U.S.C. § 112

Claims 1-25 have been rejected under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the pending rejection alleges that recitation of "may be" or "may use" in claims 1, 2, 4, 6-9, 12, 15, 18 and 21 renders the claims indefinite "because it is unclear whether the limitations following the phrase are part of the claimed invention" (August 27, 2008 Office Action, p. 4, § 5).

Though Applicants respectfully traverse this rejection and submit that the use of language such as "may be" or "may use" in the pending claims does not constitute "exemplary claim language" constituting "[d]escription of examples or preferences" leading to "confusion over the intended scope of [the] claim[s]" (MPEP 2173.05(d)), Applicants have amended claims 1, 2, 4, 6-9, 12, 15, 18 and 21 to provide clarification and/or to better track current practical implementations. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Claim Rejections - 35 U.S.C. § 101

Claims 1-25 have been rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Specifically, the pending rejection has alleged that claims 9-14 "fail to meet the above requirements [for method/process claims] because they are not tied to another statutory class of invention," and that, with regard to claims 1-12, 14-18, 20-23 and 25, "there does not appear to be any tangible result" (August 27, 2008 Office Action, pp. 5-8, § 7). Although Applicants respectfully traverse this rejection and submit that the original claims are both directed to statutory subject matter and yield results that are useful, tangible and concrete, Applicants have

amended claims 9-12, 14, 15, 17, 18, 20-23 and 25 to provide clarification, better track current practical implementations, and/or correct minor informalities. Accordingly, Applicants submit that the claims are directed to statutory subject matter and produce results that are useful, tangible and concrete, and respectfully request reconsideration and withdrawal of this basis of rejections.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 3-6, 8-9, 11, 13, 15, 17, 19-20 and 23-25 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kwoh, U.S. Patent Application No. 2001/0034625 (hereinafter, "Kwoh"). Applicants respectfully traverse this rejection and submit that Kwoh does not discuss or render obvious every element of the pending claims.

Independent claim 1 recites, *inter alia*,

An apparatus for evaluating travel accommodations,
comprising:
determine by the processor a hotel marketability index
score for at least one of the plurality of hotel properties

Applicants submit that Kwoh does not discuss or render obvious at least these elements of independent claim 1. In the pending rejection, the Examiner has cited paragraphs 0037 and 0046 as well as Figs. 5 and 10 of Kwoh as allegedly discussing the claim elements. However, Applicants submit that neither these cited portions, nor indeed any other part, of Kwoh discuss at least "determine by the processor a hotel marketability index score for at least one of the plurality of hotel properties," as recited in independent claim 1.

Paragraph 0037 of Kwoh describes elements of a hotel database, which include various hotel data such as "the number of stars that [the hotel] has received in guidebooks," "the number of beds in the hotel room," pricing information, and other accommodation information (e.g., cable television, air conditioning) (Kwoh, ¶ 0037). Similarly, Fig. 5 of Kwoh merely

illustrates elements of Kwoh's hotel database, each containing standard hotel information.

Applicants are unclear as to which part of the standard hotel information described in paragraph 0037 as being contained in Kwoh's hotel database the pending rejection is alleging as anticipating "a hotel marketability index score," or, "determine a hotel marketability index score," as recited in independent claim 1.

Paragraph 0046 of Kwoh describes customer inputs of hotel selection criteria, such as a desired number of stars, "a city in which the hotel is located," and "the number of nights that a user will stay in a hotel room" (Kwoh, ¶ 0046). Applicants submit that, inasmuch as ¶ 0046 describes user inputs, it cannot discuss or render obvious "determine by the processor a hotel marketability index score for at least one of the plurality of hotel properties," as recited in independent claim 1.

Fig. 10 of Kwoh illustrates a user interface listing of "alternative travel products" provided to a user in response to a user request for such alternatives that are consistent with the user's entered travel information (Kwoh, ¶ 0051). Applicants submit that the presentation of travel product information such as departure and return airline information, "plane class," "hotel class," "car class," "price," and "savings," do not discuss or render obvious "a hotel marketability index score," or "determine a hotel marketability index score," as recited in independent claim 1. Applicants are again unclear as to which aspect of Fig. 10 the pending rejection is alleging as anticipating the claim elements.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" [§ 2143.03, emphasis added]. As Kwoh fails to discuss or render obvious every element of

independent claim 1, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Should the Examiner maintain the rejection, Applicants respectfully request further clarification as to specifically how the Examiner believes the cited portions of Kwoh allegedly anticipate the claim elements. MPEP § 706 prescribes that, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Applicants are unclear as to how the pending rejection has alleged correspondences between claim elements and aspects of the cited reference. Accordingly, Applicants respectfully request that the Examiner clarify alleged correspondences between the claim elements and each of the cited portions of Kwoh with which the pending rejection has alleged anticipation. Furthermore, Applicants submit that the pending rejection is unclear as to which claim elements the pending rejection is alleging correspondence with each cited portion of Kwoh. Accordingly, should the Examiner maintain the rejection, Applicants respectfully request that he provide greater specificity in indicating alleged correspondences between claim elements and cited portions of Kwoh.

Although of different scope than claim 1, Applicants submit that claim 9 is patentable over Kwoh for at least similar reasons as discussed above identifying deficiencies in Kwoh with regard to independent claim 1. For example, amended independent claim 9 recites, *inter alia*,

A processor-implemented method for evaluating travel accommodations, comprising:

...

determining by the processor a hotel marketability index score for at least one of the plurality of hotel properties

Applicants respectfully submit that at least these claim elements from independent claim 9 are not discussed or rendered obvious by Kwoh, which describes a hotel database containing standard hotel information, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claim 1, Applicants submit that claim 15 is patentable over Kwoh for at least similar reasons as discussed above identifying deficiencies in Kwoh with regard to independent claim 1. For example, amended independent claim 15 recites, *inter alia*,

A processor-implemented system for evaluating travel accommodations, comprising:

...

means for determining by the processor a hotel marketability index score for at least one of the plurality of hotel properties

Applicants respectfully submit that at least these claim elements from independent claim 15 are not discussed or rendered obvious by Kwoh, which describes a hotel database containing standard hotel information, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claim 1, Applicants submit that claim 21 is patentable over Kwoh for at least similar reasons as discussed above identifying deficiencies in Kwoh with regard to independent claim 1. For example, amended independent claim 21 recites, *inter alia*,

A processor readable medium, comprising:

...

determine by the processor a hotel marketability index score for at least one of the plurality of hotel properties

Applicants respectfully submit that at least these claim elements from independent claim 21 are not discussed or rendered obvious by Kwoh, which describes a hotel database containing

standard hotel information, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicants submit claims 2-8, 10-14, 16-20 and 22-25, which are directly or indirectly dependent from independent claims 1, 9, 15 and 21 respectively, are also not discussed or rendered obvious by Kwoh, which describes a hotel database containing standard hotel information, for at least similar reasons as those discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Claim Rejections - 35 U.S.C. § 103

Claims 2, 10, 16 and 22 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kwoh in view of Dutta, et al., U.S. Patent No. 7,124,096 (hereinafter, "Dutta"); claims 4, 12 and 18 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kwoh in view of Carro, U.S. Patent No. 7,007,228 (hereinafter, "Carro"); and claim 7 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kwoh in view of Young, et al., U.S. Patent Application No. 2004/0098287 (hereinafter, "Young"). Applicants respectfully traverse these rejections and submit that the Examiner has not established a *prima facie* case of obviousness and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

Applicants submit that claims 2, 4, 7, 10, 12, 16, 18 and 22 are patentable over Kwoh for at least similar reasons to those discussed above identifying deficiencies in Kwoh with regard to independent claims 1, 9, 15 and 21. Applicants further submit that neither Dutta, which describes a search engine for submitting queries to find out availability of goods or services, Carro, which describes a system for representing and browsing geographically-based information, nor Young, which describes evaluating service providers based on payment

performance to an information provider, remedy the deficiencies identified above in Kwoh with regard to independent claims 1, 9, 15 and 21. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claim elements, there was/is no reason, rationale or motivation (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)) for such a combination of references, and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-25 all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed here or in previous amendments/responses, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements

have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-098. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-098.

Respectfully submitted,
Chadbourne & Parke LLP

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By: /Walter G. Hanchuk/

Walter G. Hanchuk
Registration No. 35,179

Chadbourne & Parke, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile